

27
#177 Reissue Litigation

PTO/SB/21 (01-03)

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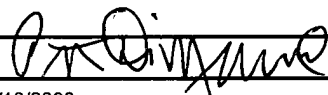
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/773,303	
	Filing Date	01-31-2001	
	First Named Inventor	PROCTOR	
	Art Unit	1638	
	Examiner Name	Amy Nelson (?)	
Total Number of Pages in This Submission	21	Attorney Docket Number	

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Firm or Individual	Peter T. DiMauro, Agent Reg. No. 47,323
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SERVICE OF PAPERS UNDER 37 CFR 1.248

The undersigned hereby certifies that the attached Protest under 37 CFR 1.291 of pending US Reissue Application 09/773,303 was transmitted via First Class Mail to applicants' representative on 03/10/2003 at the following address:

IP PATENTS
Faegre and Benson LLP
1900 Fifteenth Street
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Respectfully submitted,

Patricia M. Mue

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[illegible]

Reissue
Litigation

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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To: Honorable Director/Commissioner of the United States Patent and Trademark  
Office, Washington DC 20231

Re: Reissue Patent Application Serial No. 09/773,303  
(Reissue of: United States Patent 5,894,079, first issued 13 April 1999)

Title: "Field Bean Cultivar Named Enola"

Filing Date: 01-31-2001

Technology Center: 1638

Examiner (if known): Amy Nelson  
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PROTEST UNDER 37 C.F.R. 1.291

Hon. Director/Commissioner:

1. The undersigned is a Registered Patent Agent acting in a personal capacity offering this proper Protest of the above-captioned pending patent application. The undersigned hereby certifies that he is not acting as a representative or agent or collaborator with any other party, including the Reexamination Requestor, attorney of Reexamination Requestor, Patent Owner, litigant or potential litigant in any suit under Patent Law or Plant Variety Protection law, or any other entity. Undersigned is Director of "PatentWatch" in Washington DC, a project of the International Center for Technology Assessment, a 501(c)(3) non-profit public interest organization dedicated to evaluating the societal effects of technology. This Protest is respectfully offered in good faith only as a matter of public interest and betterment of society, to ensure that all issues under law are properly dealt with in the pending Reissue application, and to avoid duplication with any issues which have been already raised. Before any reissued

patent claims are returned to a court of law, it is only equitable for such issues to be raised in the expert forum, i.e., the USPTO: this would also ensure "judicial economy" since any judge would not have to wonder what was "on the mind" of the USPTO Examiner while evaluating the claims under each section of the Patent Act.

2. Upon information and belief, said patent application has not received a final action of any sort (no final rejection has been mailed nor has a notice of allowance been issued; the indication of certain claims as being "allowed" in a non-final action is not a "final action"). Therefore, this Protest is believed to be timely and should be entered into the file wrapper and should be fully considered prior to any action closing prosecution in this case. ¹

Furthermore, this Reissue application is *per se* timely, since no Official Gazette publication of the filing of this Reissue application, was ever published. Therefore, there are no "clocks" running from the beginning of any OG notice, since there was none.

Although USPTO PALM records (inspected at <http://pair-direct.uspto.gov>) appear to indicate than an OG Notice of this Reissue application was published on 04-03-2001, inspection of all Official Gazette notices from January 2001 to date, do not appear to show any such publication. Therefore it is believed that no Petition and no Fee under 37 CFR 1.182 is needed in this instance. If this is in error, please notify the undersigned.

¹ If a paper by the Patent Owner were to be received prior to the filing date of this Protest canceling all but the previously-indicated-"allowed" claims, such would still not serve to "close prosecution". It is the understanding of the undersigned that only a final rejection or notice of allowance (or Ex parte Quayle action), can serve to "close prosecution". Furthermore, the Examiner is reminded of the Blacklight Power cases (Blacklight Power v. Rogan), wherein the CAFC affirmed the discretionary power of USPTO to withdraw allowability of any claim at any time prior to date of issuance, even after mailing of notice of

3. This Protest is limited to only the "active" claims, those claims which have been constructively elected and which are not withdrawn from consideration: i.e., claims 1-15, 51-52, and 54-58.

NEW ISSUE #1: INDEFINITE SCOPE OF CLAIMS:

The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent.

4. Claims 1-7 are believed to be indefinite under 35 U.S.C. 112, second paragraph, since they do not clearly inform the public of the boundaries of what constitutes infringement of the patent.

5. Claim 1 is directed to a field bean seed, ostensibly like any other field bean seed except that it has been deposited with the ATCC (American Type Culture Collection) as accession # 209549.

6. The initial rhetorical question which must be asked is: does a hypothetical practitioner have to "make, use or sell" seeds procured or obtained from ATCC to be operating within the scope of claim 1, --- or --- can said practitioner make, use or sell *Phaseolus Vulgaris* seeds which have been bred or found in some other way and still be within the scope of claim 1? If the answer is the former, then the claims *are* clear: only those practitioners who without authorization obtain seeds from ATCC are operating within its scope. If the answer is the latter, then it necessarily

begs the question: which field bean seeds? The claims do not give a hint to this and thus fail to serve their "notice" function.

7. There is legal authority for questioning whether a claim to an object, which is identified only by some accession number, "particularly and distinctly" points out the subject matter sought to be patented. This authority comes from precedential decisions regarding the "doctrine of incorporation by reference".

8. According to Ex parte Fressola, (27 USPQ2d 1608, 1609, Bd. Pat. App. & Inter. 1993) , one may incorporate-by-reference into a claim some specific figure or table from elsewhere. However, it is "is permitted **only** [emphasis added] in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant's convenience." Claim 1 manifestly fails the "necessity" doctrine. Evidence for this is found in the fact that the claimed subject matter can be described in words, entirely without reference to the specification or drawings or ex situ depository, as evidenced by seed claims 13-15 and 51-52, and 54-58.²

9. The aim, the end, the purpose of patent claims, is to point out particularly and distinctly define the invention to be secured to the individual. A claim that refers to a *ex situ* depository (namely, the ATCC)

² These claims are directed to yellowish seeds and an assertedly objective test is disclosed. But what is the objective test for determining whether a seed is within the scope of some numbered seed?

defeats the purpose of a claim. The limited exceptions which permit incorporation by reference simply do not apply.

10. The Examiner may wonder, "Why would a claim incorporating by reference an accession number, even improperly, be unclear?" The answer is, that there will be great difficulty and inconsistency in interpreting subject matter which is incorporated by reference (be it the specification, drawings, or some seed accession number), because such subject matter has no fixed legal meaning. Claim 1 is indefinite because it is impossible to determine the legal meaning of "seed with accession number 209549", (or to what extent claim 1 would be interpreted to cover equivalents). It has no more legal meaning than would a claim to a "seed as described in the foregoing specification". Claim 1 is indefinite because it is impossible to determine how much of the inherent properties of ATCC 209549 is incorporated by reference into claim 1, or to what extent claims 1 would be interpreted to cover equivalents. Claim 1 can be interpreted to read on the whole, or any part of the inherent properties of ATCC 209549; it is this very ambiguity which mandates that a Paragraph 2 rejection be made. Is it the "yellowness" property of ATCC 209549 which has been imported into claim 1, or is it every single inherent property?

11. The following statement at the end of the specification also renders indefinite the scope of claim 1:

"By way of example, not of limitation, the following examples are given". See column 4, lines 55-56 of the Patent.

So, if arguendo one were to posit that the Examiner has considered all the morphological properties of Example 1 to be "present" in claim 1, this would fly in the face of the Patentee expressly stating that Example 1 does not limit any of the claims!!

12. In view of the above statement from the Patent specification, it is impossible to tell what parts of specification Example 1 are and are not intended to be limiting, or what modifications would fall within the scope of claim 1.

13. More on point, would be a hypothetical claim to: "the tool which is in the far left corner of the inventor's garage". Does one have to go into the inventor's garage and grab the tool to infringe, or can "it" be independently derived, and if so, how similar does "it" have to be to the tool in the garage in order to infringe?

14. Claim 1 answers none of these questions.

15. It is respectfully submitted that the Examiner cannot "pass" on these questions. Please note the following verbatim passage from the MPEP:

"In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the **examiner must** consider the claim as a whole to **determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph.** See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000)."³

³ See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished)
Protest under 37 CFR 1.291 of 09/773,303

16. Furthermore, if the scope of the invention sought to be patented cannot be determined from the *language* of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. 112, second paragraph must be made. In re Wiggins, 488 F.2d 538, 179 USPQ 421 (CCPA 1973).

17. A positive "declaratory judgment" of just what is the scope of claim 1 is required by equity, since it is the belief of the undersigned that there are alleged infringers of claim 1 against whom suit has already been brought by the Patent Owner, which suit has believed to have been stayed pending the outcome of the present Reissue proceedings. Those alleged infringers deserve to have the benefit of just what the Examiner considers to be the scope of claim 1.⁴ In deciding patentability issues, the Federal Circuit observed the following in Panduit Corp. v. Dennison Manufacturing Co., (810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987)): "Analysis begins with a key legal question--what is the invention claimed?" since "[c]laim interpretation . . . will normally control the remainder of the decisional process."

18. So, legally, what is the invention claimed in claim 1? The Examiner is respectfully requested to so state.

19. It is respectfully submitted that the Examiner cannot "pass" on the above questions, by merely making reference to the "presumption of

⁴ If a " reasons for allowance" stated that a claim is "reasonably clear to the person having ordinary skill in the relevant art", this would not provide indication of claim scope.

validity” of unamended issued patent claims, or to the allegedly limited scope of *ex parte* reexaminations. What is under examination presently is a patent application, not a patent; validity has been temporarily surrendered by the Patent Owner during the course of these reissue proceedings, and during any *ex parte* proceedings the presumption of validity is waived. Furthermore, once the instant proceedings were effectively converted from an *ex parte* reexamination to a reissue application, the alleged limited scope of reexamination was mooted.

20. The Examiner cannot “pass” on the question of “just what is the scope of claim 1” by reason of the permissibility of seed deposit. While it is noted that the USPTO accepts seed deposits under Rules 37 C.F.R. 1.800 *et seq.*, note that the use of the deposit system is in no way a substitute for the mandates of 35 U.S.C. 112, especially the second paragraph thereof. Evidence for this fact is found in the Federal Register, wherein the USPTO has stated that:

“These rules [viz., 37 CFR 1.800 *et seq.*] are intended to address procedural matters in the deposit of biological material for patent purposes. They are not designed to decide substantive issues such as whether a deposit of a particular organism or material would be recognized or necessary for the purposes of satisfying the statutory requirements for patentability under 35 U.S.C. 112.”⁵

At best, one may appeal to recent Federal Circuit decisions to argue that there is adequate written description for claim 1,⁶ but this is not tantamount to claim 1 clearly serving its notice function.

⁵ Federal Register, Volume 66, #4, Friday January 5, 2001.

⁶ Enzo Biochem, Inc., v. Gen-Probe, Inc., No. 01-1230, slip op. (Fed. Cir. July 15, 2002) (“Enzo II”).
Protest under 37 CFR 1.291 of 09/773,303

21. The following excerpted Board decision, although not precedential, should prove illuminating to the Examiner in deciding whether he/she should declare what is the scope of claim 1:⁷

“The examiner should initially review each claim pending in this reexamination and determine its scope, using appropriate legal standards for ex parte examination. The record should reflect in what manner the examiner has interpreted the claims and, thus, on what basis the patentability of the claims has been determined. The facts in *Genentech, Inc. v. Wellcome Foundation Ltd.*, 29 F.3d 1555, 31 USPQ2d 1161 (Fed. Cir. 1994) serve as an example of the difficulties which can arise when a patent issues and the record does not reflect how the examiner interpreted the claims and determined patentability. There, a phrase used in the claims, tissue plasminogen activator, was defined in four different ways in the specification. *Genentech*, at 1563, 31 USPQ2d at 1167. The court observed that ‘[t]hese diverse definitions reflect either inartful drafting, a conscious attempt to create ambiguity about the scope of the claims, or a desire to claim a wide variety of materials not described or enabled in the specification,’ *Genentech*, at 1564, 31 USPQ 2d at 1167. The court resolved that situation by avoiding ‘those definitions upon which the PTO could not reasonably have relied when it issued the patent.’ *Id.* This was seen to be appropriate because it avoided ‘the possibility of an applicant obtaining in court a scope of protection which encompasses subject matter that, through the conscious efforts of the applicant, the PTO did not examine.’ *Id.* (footnote omitted). Here, *the examiner has yet another opportunity to create a record which will indicate to those who follow on what basis the claims pending in this reexamination were determined to be patentable or unpatentable.*”

⁷ See *Ex parte Biocyte*, Reexamination Control No. 90/003182, Appeal No. 96-2079.

22. Claim 2 is indefinite under 35 USC 112, second paragraph, to substantially the same extent as is claim 1. All of foregoing paragraphs 5-21 are expressly re-alleged to apply to claim 2. Claim 2 is directed to a plant grown from the seed of claim 1. In like manner, one rhetorical question would be, "which of all the possible inherent phenotypic ⁸ properties are present in claim 2?". Alternatively, the question would be "would only those plants grown from the deposited seed be within the claim's scope, or could other plants be within the scope as well, and if so, which ones?".

23. Claim 3 is indefinite under 35 USC 112, second paragraph, to substantially the same extent as are claims 1-2. All of foregoing paragraphs 5-22 are expressly re-alleged to apply to claim 3. Claim 3 is directed to the pollen from a plant grown from the seed of claim 1. In like manner, one rhetorical question would be, "which of all the possible inherent phenotypic properties are present in claim 3?". Alternatively, the question would be "would only the pollen from those plants grown from the deposited seed be within the claim's scope, or could other pollen be within the scope as well, and if so, which ones?".

24. Claims 5-8 are indefinite under 35 USC 112, second paragraph, to substantially the same extent as is claims 1. All of foregoing paragraphs 5-22 are expressly re-alleged to apply to claims 5-8.

25. Claim 4 is not of the same scope as claim 2. However, claim 4 is still indefinite under 35 USC 112, second paragraph. Claim 4 is directed

⁸ It is curious that the record makes mention of some sort of "unique" genotypic properties of the deposited seed; however, no genotypic information is disclosed in the specification, nor have any such tests been

to a plant having "all of the physiological and morphological characteristics of" a certain plant grown from banked seed. But the question remains, is the claim referring to the set of characteristics which are disclosed in instant Example 1, or is it referring to the set of "all inherent characteristics"? The two sets are clearly not co-extensive. If in the Examiner's view, the claim is referring to the set of characteristics disclosed in Example 1, then the claim fails the aforementioned "necessity" test for proper incorporation by reference, and this claim interpretation is squarely contradicted by the language in the specification warning against limiting the claims to the Example. If in the Examiner's view the claim is referring to "all inherent characteristics" of the plant grown from the banked seed, this raises a unique question: under what conditions was the plant grown? It is respectfully submitted that the Examiner ought to know that conditions such as photoperiod, soil type, nutrients, air quality, and many others, can profoundly affect the physiological and morphological characteristics of any living plant; and yet, these are not named in the claim.


So, would a practitioner who brazenly acquires and plants seeds from ATCC, but who stunts the growth of the plant somewhat so as to have some unusually short plant, evade the scope of the claim? Questions regarding this claim should highlight the whole failed concept of having any patents on any living organisms, since: (a) organisms make themselves; (b) organisms cannot be described in words nor reproduced by words; (c) organisms do not always grow to precise specification. All of foregoing paragraphs 5-22 are expressly re-alleged to the extent they apply to claim 4.

carried out except to the extent that they determine the deposited seed to be identical to prior art seeds!! It is unknown how the examiner could know the seeds have a unique genotype.

25. As per 37 CFR 1.291(b), this Protest includes a listing of the printed publication relied upon, on PTO form 1449; and a copy of the printed publication listed on Form 1449. The concise explanation of said printed publication is as follows:

“The SEROTA document is a United States Patent and Trademark Office Board of Patent Appeals and Interferences precedential decision setting forth the proper practice for rejecting a claim which ‘incorporates by reference’ subject matter found elsewhere, under 35 USC 112, second paragraph.”

Respectfully submitted,



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(None of the foregoing constitutes “legal advice” and the signatory is not acting in a representative capacity for any party.)